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PATENT APPLICATION

ATTORNEY DOCKET NO. 10008320-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Walls, et al.

Confirmation No.: 7156

Application No.: 09/974,555

Examiner: Madamba, Glenford J.

Filing Date: October 9, 2001

Group Art Unit: 2151

Title: System and Method for Configuring a Plurality of Computers that Collectively Render a Display

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on November 28, 2005.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

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Respectfully submitted,

Walls, et al.

By 

Daniel R. McClure

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Rev 10/05 (ReplyBrief)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

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|--|---|--------------------------------|
| In Re Application of: |) | |
| Walls, et al. |) | Group Art Unit: 2151 |
| Serial No.: 09/974,555 |) | Examiner: Madamba, Glenford J. |
| Filed: October 9, 2001 |) | Confirmation No. 7156 |
| For: System and Method for Configuring |) | HP Docket No.: 10008320-1 |
| A Plurality of Computers That Collectively |) | TKHR Docket: 50819-1370 |
| Render a Display |) | |

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Daniel R. McClure

REPLY BRIEF

Mail Stop Appeals - Patents
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is in reply to the Examiner's Answer, which was mailed November 28, 2005.

Response to Examiner's Answer

Applicants continue to disagree with the Examiner's positions as to all claims presently rejected. Applicants' Appeal Brief sets forth, from a substantive basis, the reasons why the cited

art does not properly teach the features that are being claimed. The substance of the Examiner's Answer simply reiterates the prior positions taken by the Examiner during the prosecution of this application. Therefore, rather than restate or reiterate the rather lengthy bases and reasons why Applicants continue to disagree with the Examiner, Applicants stand behind those reasons already set forth and repeat and re-allege herein the positions set forth in the Appeal Brief.

Simply stated, the Board should overturn all rejections due to fundamental misapplications of the cited art, as detailed in the Appeal Brief. In addition to the arguments in the Appeal Brief, Applicants briefly set forth the following additional comments, which were necessitated by the arguments in the Examiner's Answer.

At the outset, Applicants note that the positions set forth in the Examiner's Answer are internally inconsistent. In this regard, the Examiner seeks to justify his overly broad claim interpretation by stating "Examiner believed Applicant intended broad interpretation to be given to the claims...." (Examiner's Answer, p. 20). The Examiner makes this statement despite refusing to give a more limited interpretation to certain claim elements, as urged by Applicants throughout the prosecution of this application. This is clearly erroneous, as Applicant has clearly articulated that the proper scope of claim 1 should be narrower than the scope the Examiner has accorded it.

As one example, the Examiner refused to consider the argument that the "configuration" relates to the configuration of a plurality of slave computers to collectively render a display. As justification for refusing to consider this argument, the Examiner stated that this claim language has "not been given [] patentable weight because the recitation occurs in the preamble."

Applicants submit, however, that the Examiner's interpretation errs by failing to give any weight to the preamble, which defines the environment of the invention as "configuring a plurality of

networked slave computers to cooperate to collectively render a display.” Applicants understand that not all limitations of a preamble are given patentable weight. However, those limitations that breathe life and meaning into the claim ARE to be given patentable weight. *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995). In the context of claim 1, the preamble gives meaning to the elements of “specifying ... a ... compatible operating configuration for each of the plurality of slave computers” and “communicating ... the specified configuration to each of the plurality of slave computers.” Indeed, during examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). Further, a “preamble may provide context for claim construction, particularly where that preamble’s statement of intended use forms the basis for distinguishing the prior art in the patent’s prosecution history.” *Metabolite Labs, Inc. v. Corp. of Amer. Holdings*, 370 F.3d 1354, 1358-62 (Fed. Cir. 2004); M.P.E.P. §2111.01. See, also, *Catalina Mktg. Int’l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808-09, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002) (“[C]lear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention.”). For at least these reasons, the Examiner’s failure to give any patentable weight to the preamble constitutes error, which should be overturned.

As another example, Applicants have argued that the claimed feature of “specifying compatible operating configurations” should properly be construed in accordance with the

relevant teaching of the specification, which described the operating configuration as “configuration of the graphics hardware/software to properly render graphics on a display.” The Examiner, however, refused to consider this relevant teaching from the specification, by relying on the statement of law that “limitations from the specification cannot be read or imported into the claims. See *In re Van Geuns*...” (Examiner’s Answer, P. 15).

While Applicants continue to disagree with these positions, it is certainly clear that the Examiner’s statement that “Examiner believed Applicant intended broad interpretation be given to the claims” (Office Action, p. 20) is clearly inconsistent with the Examiner’s other arguments.

Applicants continue to fundamentally disagree with the Examiner’s overly broad interpretation of the claim language. Applicants understand that the Examiner should give claims their broadest reasonable interpretation. However, the broadest reasonable interpretation is not the same as the broadest possible interpretation. The present interpretation goes beyond the permissible limit. Claim 1 expressly recites “specifying ... a ... compatible operating configuration for each of the plurality of slave computers” and “communicating ... the specified configuration to each of the plurality of slave computers.” *Ludtke* merely teaches the partitioning of a video stream to be displayed across a plurality of computer displays. Indeed, *Ludtke* does not configure anything. Simply stated, the partitioning of video data (i.e., the content to be displayed) is significantly different than the configuration of the plurality of computer to display partitioned video. In this respect, *Ludtke* teaches nothing more than Applicants admitted to be prior art. The Examiner, however, refuses to give any patentable weight to what it means to specify a compatible configuration of the slave computers. To interpret the claims in the way that the Examiner does completely ignores the relevant teachings of the specification, and indeed

essentially ignores the very claim terms themselves. Applicants understand and accept the fact that limitations from the specification are not to be incorporated into the claims. However, the Examiner cannot properly ignore the clear teachings of the specification that give meaning and context to the express language of the claims. *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 1580 (Fed. Cir. 1988). The present interpretation of the claims ignores the meaning and context of the terms "specifying" and "compatible operating configuration." For at least this reason, the Board should overturn the Examiner's rejections.

Simply stated, the Applicants and the Examiner have a fundamental disagreement as to the applicability of the cited art to the presently pending claims and the appropriateness of the rejections set forth. Fundamentally, Applicants and Examiner disagree on how the phrase "specifying ... a ... compatible operating configuration for each of the plurality of slave computers" should be construed. For at least the foregoing reasons, as more fully set forth in the Appeal Brief, Applicants respectfully submit that the Board should overturn the rejections of the Examiner.

No fees are believed to be due in connection with this Reply Brief. If, however, any additional fees are deemed to be payable, you are hereby authorized to charge any such fees to deposit account No. 08-2025.

Respectfully submitted,



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